

Serial No. 10/604,083  
Filed: 06/25/2003  
Page 2 of 7

Examiner: John C. Hong  
Group Art Unit: 3726

#### REMARKS

Claims 1-36 were in the application as filed. The Examiner previously required restriction between alleged invention I (claims 1-18, 23-36) and alleged invention II (claims 19-22). In the Response filed November 29, 2004, Applicant provisionally elected alleged invention I (claims 1-18, 23-36) with traverse. In the May 18, 2005, Amendment and Response to the March 10, 2005, Office Action, Applicant added claims 37-41.

#### Restriction Requirement

The Examiner has required restriction between 3 alleged patentably distinct species of the invention. The alleged species include:

- Species I (claims 1-18 and 41; Figures 4-7), which relates to a tool for removing a friction-fit or press-fit component from a seat comprising a coupling redirecting the percussive force at the forward end of the hammer to a component located rearwardly of the hammer;
- Species II (claims 38 and 40; Figure 9), which relates to a tool for removing a friction-fit or press-fit component from a seat comprising a cap and anvil attached to the hammer;
- Species III (claims 23-37 and 39; Figures 10-11), which relates to a tool/kit comprising a pull rod interconnected with a component located rearwardly of the air hammer (a mounting portion and rear portion/coupling is attached to a rearward end).

The restriction requirement is respectfully traversed as being improper.

Alleged Species I-III have the unifying concept of a pneumatic tool having a reciprocating percussion assembly operably connected to a pull rod attached to a body to be removed from a

Serial No. 10/604,083  
Filed: 06/25/2003  
Page 3 of 7

Examiner: John C. Hong  
Group Art Unit: 3726

seat in which it is frictionally retained. The alleged Species are not independent and distinct.

Restriction may be required if two or more "independent and distinct" inventions are claimed in one application. 35 U.S.C. §121. According to the Manual of Patent Examination Procedure §802.01, "independent" means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect. "Distinct" means that two or more subjects as disclosed are related, for example, as a combination and a part or subcombination thereof, a process and an apparatus for its practice, a process and a product made, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable over each other.

The Examiner's alleged species are dependent, not independent, because they have the same basic modes of operation, functions, and effects, and are therefore related. Each of the alleged species has the same basic mode of operation, i.e. a pneumatically driven movable member percussively impacting a stationary member attached to a frictionally retained body. Each of the alleged species has the same function, i.e. removal of a frictionally retained body from a seat. Each of the alleged species has the same effect, i.e. the progressive removal of a frictionally seated body through the controlled application of a reciprocating percussive force by a hand-held pneumatically powered tool. Thus, the Examiner's alleged species are dependent.

The Examiner's alleged species are also not distinct. The Examiner has not shown that the three alleged species are capable of separate manufacture, use, or sale as claimed. Furthermore, the Examiner has not shown that the three alleged species are patentable over each other. Indeed, it is highly likely that the three alleged species would be found not to be patentable over each other as obvious variants.

In particular, alleged Species II and III are not distinct relative to each other. For example, claim 37 relates to a coupling interconnecting a pneumatically-driven hammer and a component pursuant to which a repeating percussive force is applied to the component. Claim 38

Serial No. 10/604,083  
Filed: 06/25/2003  
Page 4 of 7

Examiner: John C. Hong  
Group Art Unit: 3726

relates to a pneumatically-driven hammer attached to a cap having an anvil for applying a percussive force to the anvil through the hammer to a component. Claim 39 relates to an air hammer attached to a pulling member percussively communicating with a pull rod attached to a component. Claim 40 relates to an air hammer attached to a pulling member percussively communicating with a pull rod attached to a component. A cap having an anvil is attached to the hammer for applying a percussive force through the hammer to the component. Each of these four claims describes a pneumatically-driven hammer connected to a component and applying a percussive force to a component through a member connecting the hammer to the component. The alleged species defined by claims 37-40 are not capable of separate manufacture, use, or sale as claimed, and are not patentable over each other. Thus, Species II and III are not independent and distinct, and should not be subject to a species restriction.

A search of the prior art would not be duplicative and Applicants are at a loss as to how the Examiner would be burdened by having to examine all the groups of claims since they relate to such intertwined subject matter. The Manual of Patent Examining Procedure provides that a restriction is proper if the application contains a multiplicity of inventions so that an unduly extensive and burdensome search is required. However, this is not the case with Applicant's patent application. Rather, the above-identified unifying concept defining Applicant's invention would not appear to necessitate an unduly extensive or burdensome search by the Examiner. The search must be performed within essentially the same area to uncover potentially relevant prior art.

Furthermore, if the Examiner's requirement for restriction is maintained, Applicant would be required to file additional patent applications containing the alleged patentably distinct inventions identified by the Examiner. If all of those patent applications were allowed, the net result would be several patents that claim closely related inventions differing only by a particular embodiment. Applicant respectfully asserts that the Examiner's restriction requirement is inappropriate.

Serial No. 10/604,083  
Filed: 06/25/2003  
Page 5 of 7

Examiner: John C. Hong  
Group Art Unit: 3726

As the Examiner is undoubtedly aware, 37 CFR 1.141(a) states:

Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

*See, also, Manual of Patent Examining Procedure, §§806.04(a), 806.04(h).* Thus, 37 CFR 1.141(a) recognizes that a single application can properly include claims to a reasonable number of species greater than one provided the application includes an allowable generic claim from which the species claims depend. This is precisely the situation with respect to alleged Species II and III. The Examiner has identified no claim as generic to all three alleged species. However, Applicant submits that at least claims 32 and 37 are generic to alleged Species II and III. While no decision has yet been made concerning the allowability of generic claims, the species claims must be examined if a claim generic to the species is allowed. *See, MPEP §809.02(c).*

There is good reason to maintain the Species II and III claims in the application for examination pending allowance of one or more generic claims. The number of species, i.e. two, is not unreasonable. Applicant submits that there is a high likelihood that one or more generic claims relative to these two species will be allowed. Applicant would withdraw only 2 claims (claims 38 and 40 of Species II) pursuant to the species restriction requirement between Species II and III. Thus, the burden of maintaining the Species II and III claims in the application is negligible, and far outweighed by the burden of continuing examination of the withdrawn claims after allowance of a generic claim. Nevertheless, Applicant confirms a provisional election with traverse of alleged III (claims 23-37 and 39).

Serial No. 10/604,083  
Filed: 06/25/2003  
Page 6 of 7

Examiner: John C. Hong  
Group Art Unit: 3726

### **Election of Species**

Applicant provisionally elects alleged Species III, claims 23-37 and 39, with traverse. Applicant also submits that examination should continue relative to alleged Species II, and thereby also provisionally elects claims 38 and 40, with traverse.

The Examiner has indicated that no claims are generic. However, Applicant submits that at least claims 32 and 37 are generic to Species II and III. As the Examiner is undoubtedly aware, MPEP §809.02(c) states:

(B) When a generic claim is subsequently found to be allowable, and not more than a reasonable number of additional species are claimed, treatment shall be as follows:

(1) When all claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be advised of the allowable generic claim and that **claims drawn to the nonelected species are no longer withdrawn** since they are fully embraced by the allowed generic claim. (Emphasis added.)

Upon the allowance of a generic claim, Applicant will be entitled to consideration of all claims drawn to a species which is non-elected as a result of the restriction requirement. *See, 37 CFR 1.146.*

### **CONCLUSION**

Applicant asserts that the restriction requirement should be withdrawn. However, to comply with the requirements set forth by the Examiner, for these reasons, Applicant provisionally elects alleged Species III, claims 23-37 and 39, with traverse. Applicant also submits that examination should continue relative to alleged Species II, and thereby also provisionally elects claims 38 and 40, with traverse.

Serial No. 10/604,083  
Filed: 06/25/2003  
Page 7 of 7

Examiner: John C. Hong  
Group Art Unit: 3726

If there are any outstanding issues which the Examiner feels may be resolved by way of telephone conference, the Examiner is cordially invited to contact the undersigned to resolve these issues. Early notification of allowability is respectfully requested.

Respectfully submitted,

JAMES PANKS

Dated: September 8, 2005

By: 

G. Thomas Williams, Reg. No. 42,228  
Michael F. Kelly, Reg. No. 50,859  
McGARRY BAIR PC  
171 Monroe Avenue, NW, Suite 600  
Grand Rapids, Michigan 49503  
616-742-3500

G0186375.DOC